

REMARKS

Claims 1-19 are presented for examination. Claims 16-19 are found allowable subject to being rewritten in independent form. §

REJECTION UNDER 35 U.S.C. § 102

The Office Action indicates that claims 1-4, 7 and 9-19 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kuroda et al. It is noted that this rejection is improper because the Examiner does not address claims 16-19 in this rejection. Moreover, as indicated above, claims 16-19 are found allowable subject to being rewritten in independent form.

Further, the rejection of claims 1-4, 7 and 9-15 is respectfully traversed for the following reasons.

It is well settled that anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied*, 110 S.Ct. 154 (1989).

Claim 1 recites a memory system for a portable telephone including a signal transmission/reception portion for transmitting and receiving a signal and a control portion for controlling at least a signal transmission and reception operation of said transmission/reception portion. The memory system comprises:

- a random access memory providing a working area for said control portion; and
- a flash memory including a memory array for storing a program for said control portion and at least transmission and reception data in a non-volatile manner under a control of said control portion.

Claim 1 specifies that the memory array is divided into a plurality of storage units, and a register, provided commonly to the respective storage units, and having information in a storage unit of said plurality of storage units transmitted thereinto and allowing serial readout of the transmitted information.

Independent claim 12 also recites that the memory array is divided into a plurality of storage units, information in one unit of the storage units is allowed to be serially read out in synchronization with a clock signal.

The Examiner relies upon col. 32, lines 61 to col. 33, line 2 for disclosing the claimed structure of the memory array. This portion of the reference discloses that a flash memory is used as a memory device of microcomputer 102 (FIG. 41). However, Kuroda does not teach or suggest that this flash memory has a memory array arranged in the claimed manner.

Considering the reference, FIGS. 13 and 35 of Kuroda show the division of the memory array into a plurality of storage units. However, no register is provided commonly to the storage units.

Moreover, paragraph [0072] of Kuroda discloses that the memory array is divided into seven large blocks and eight small blocks. However, no register for transferring data is provided commonly to the blocks.

Further, the Examiner relies upon inherency for disclosing information read out from a storage unit of the flash memory in synchronization with a clock signal.

It appears that the Examiner bases her conclusion on Kuroda's teaching of serial communication interface SCI and timer TMR (FIG. 1). Also, the Examiner appears to rely upon timing diagrams in FIG. 28 for showing the serial readout of information from a register in the flash memory.

It is well settled that in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner provided no factual basis upon which to conclude that Kuroda's arrangement contains a memory array divided into a plurality of storage units, and information in one unit of the storage units is allowed to be serially read out in synchronization with a clock signal, as claim 12 requires, or contains a register, provided commonly to the respective storage units, having information in a storage unit transmitted thereinto and allowing serial readout of the transmitted information, as claim 1 requires.

As discussed above, it appears that the Examiner bases her conclusion on Kuroda's teaching of serial communication interface SCI and timer TMR (FIG. 1). However, the serial interface SCI of Kuroda is used for external data transfer, rather than for internal data transfer within the flash memory. Accordingly, one skilled in the art would understand that the serial interface SCI of Kuroda is not able to allow information in one unit of the storage units to be

serially read out in synchronization with a clock signal, as claim 12 requires. Also, the serial interface SCI of Kuroda cannot allow serial readout of the information transmitted to a register, provided commonly to the respective storage units, as claim 1 requires.

Also, the Examiner appears to rely upon timing diagrams in FIG. 28 for showing the serial readout of information from a register in the flash memory. However, in the timing diagrams in FIG. 28 of Kuroda, an address is applied in synchronization with the clock signal. However, the read out data is outputted asynchronously with respect to the clock signal. Therefore, contrary to the Examiner's conclusion, the timing diagrams in FIG. 28 show that the Kuroda structure does not allow the information in one unit of the storage units to be serially read out in synchronization with a clock signal, as claim 12 requires. Moreover, the timing diagrams in FIG. 28 do not suggest serial readout of the information transmitted to a register, provided commonly to the respective storage units, as claim 1 requires.

Therefore, Kuroda neither expressly nor under the principles of inherency discloses the arrangements recited in independent claims 1 and 12. Dependent claims 2-4, 7, 9-11 and 13-15 are defined over Kuroda at least for the reasons presented above in connection with respective independent claims 1 and 12.

Hence, the rejection of claims 1-4, 7 and 9-15 under 35 U.S.C. § 102 is improper and should be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

Dependent claims 5, 6 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kuroda et al. This rejection is respectfully transferred for the following reasons.

Claim 5 recites that the file storage flash memory constitutes a memory card being attachable and detachable to and from the bus converting circuit. Claim 8 dependent from claim

5 specifies that the bus converting circuit is formed into an adapter attachable and detachable to the portable telephone.

Claim 6 recites that the control portion, random access memory and flash memory are integrally formed as a control unit.

The Examiner admits that Kuroda does not disclose the claimed arrangements. However, she considers these arrangements to be obvious design choices. This Examiner's assertion is respectfully traversed.

It is well settled that the burden of establishing a *prima facie* case of obviousness falls upon the Examiner. Therefore, the evidence upon which the Examiner relies must clearly indicate that a worker of routine skill in the art would view the claimed invention as being obvious, as meant by 35 U.S.C. § 103. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd.App.1979).

However, the Examiner provided no factual basis upon which to conclude that the above-discussed features recited in claim 5, 6 and 8 are obvious for a worker of routine skill in the art.

Moreover, in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

The reference provides no suggestion for the modifications proposed by the Examiner. If the Examiner relied upon common knowledge of the art or "well known" prior art without expressly indicating such reliance, the Examiner is respectfully requested to cite a reference in support of her position (see MPEP 2144.03).

Accordingly, the rejection of claims 5, 6 and 8 under 35 U.S.C. § 103 is improper because the Examiner has failed to establish a *prima facie* case of obviousness.

In view of the foregoing, and in summary, claims 1-19 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Alexander V. Yampolsky
Registration No. 36,324

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AVY:MWE
Facsimile: (202) 756-8087
Date: May 12, 2004